

REMARKS/ARGUMENTS

Claims 34-69 are active in this application.

Claims 1-33 have been re-presented as Claims 34-69 to avoid printing errors when the claims are published in the issued patent. Claim 34 corresponds to original Claims 1 and 3. Claims 35-69 correspond to Claims 2 and 4-33. The objections to the claims and the rejections under 35 U.S.C. § 112, second paragraph are obviated by the cancellation of Claims 1-25.

A substitute Abstract is attached hereto.

No new matter is added.

Applicants thank the Examiner for withdrawing the Restriction Requirement and examining all pending claims.

The Rejection under 35 U.S.C. § 102(b)

The rejection of Claims 1-8, 12-25 and 33 under 35 U.S.C. § 102(b) over Torgerson (U.S. patent no. 5,730,966) is obviated by the cancellation of the claims. As this rejection may apply to Claims 34-69, now pending, the rejection is untenable for the following reasons.

For Torgerson to anticipate the claimed subject matter the disclosure of Torgerson must allow one of ordinary skill to “at once envisage” the claimed invention. *In re Petering* 133 USPQ 275 (CCPA, 1962). Since the claimed invention cannot be at once envisioned from Torgerson, the claims are not anticipated by Torgerson.

Torgerson does not describe, with sufficient specificity, the selection of a composition of at least one compound with an optical effect and a polymer comprising water-soluble units and units having in water a lower critical solution temperature LCST as claimed.

Torgerson describes water or alcohol dispersible elastomeric copolymers useful in cosmetic applications. The copolymers of Torgerson contains randomly polymerized

monomers which provide repeating units A and B (col. 3 of Torgerson). Torgerson generically describes each monomer and the combinations that would result from selecting any particular monomer from each group is enormous (see cols. 2-3 and 8-9).

Torgerson is concerned with selecting monomers based on certain polymer properties, i.e., flexibility, elasticity, solubility, glass transition temperatures ( $T_g$ ), molecular weights, and strength, which are properties useful for hair styling compositions (see col. 1, line 64 to col. 2, line 3; and col. 4, lines 54-55).

More specifically, Torgerson is concerned with preparing and utilizing graft copolymers:

The present invention relates to a water or alcohol soluble or dispersible thermoplastic elastomeric copolymer having a **backbone and two or more polymeric pendant side chains . . .** (col. 2, lines 37-39, emphasis added).

The copolymers of the present invention, can also be referred to as "**graft copolymers**" because they can be prepared from the copolymerization of monomer units and macromonomer units. *In other words, the macromonomer is "grafted" or incorporated into the copolymer.* (col. 4, lines 59-63, emphasis added).

Further, Torgerson describes the graft copolymers as:

characterized in having an elastomeric or flexible backbone and rigid, thermoplastic, hydrophilic side chains. (col. 4, lines 55-56)

Claim 34 (which is a combination of original Claims 1 and 3) define the polymer in two alternative ways:

- (1) "the polymer is a block polymer comprising water-soluble units alternating with units with an LCST" or
- (2) a graft copolymer whose backbone is formed from water-soluble units and bears LCST grafts"

Concerning the first option in Claim 34, clearly a block copolymer with alternating units of water-soluble and LCST blocks is clearly different than the grafted polymers described by Torgerson (see the above-reproduced sections from Torgerson). Therefore, even if one could simply pick and choose the appropriate monomers, the monomers would not be arranged as in the present claims following the description in Torgerson.

Concerning the second option in Claim 34, i.e., water-soluble backbone with LCST grafts, this polymer is not described in Torgerson because at col. 5, line 48-62 Torgerson describes:

The copolymers of the present invention are formed from the copolymerization of randomly repeating A and B units . . . In typical embodiments of these copolymers, **the backbone is primarily derived from the ethylenically unsaturated portion of the A monomer unit and the ethylenically unsaturated portion of the B macromonomer unit.** *The side chains are derived from the non-copolymerized portions of the macromonomer.*

Further, Torgerson describes that the water-soluble monomers that impart the polymer with water-solubility, see again col. 4, lines 55-56 of Torgerson: “an elastomeric or flexible backbone and rigid, thermoplastic, hydrophilic side chains.”

There is also no direction in Torgerson to specifically select a composition of an aqueous phase, at least one compound with an optical effect and a polymer comprising water-soluble units and units having in water a lower critical solution temperature LCST as claimed.

As stated above, Torgerson must disclose a more specific, limited teaching to chose those polymers in the claimed composition, *In re Petering, supra*; see also *In re Ruschig*, 145 U.S.P.Q. 274 (CCPA 1965). Torgerson is silent with respect to selecting those polymers and thus does not provide an anticipating disclosure to present claims.

On this basis, Applicants request withdrawal of the rejection over Togerson.

Obviousness-Type Double Patenting Rejections

Various combinations of the claims have been rejected under the doctrine of obviousness-type double patenting in view of several co-pending applications and U.S. patent no 6,689,956 (U.S. '956).

Concerning the rejection as it pertains to 6,689,956 appears to be an error as this patent relates to an electrical bus duct system with heat-dissipating enclosure. Accordingly, withdrawal of the rejection in view of 6,689,956 is requested.

Concerning the rejections in view of U.S. 10/070,922; U.S. 10/070,910; U.S. 10/069,981; U.S. 10/197,560; and 10/197,555, Applicants request that these rejections be held in abeyance since the alleged conflicting claims have not yet been patented. Further, Applicants note the following from MPEP § 822.01:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Furthermore, the copending application 10/197,560 claims a cosmetic composition containing a water-soluble or water-dispersible polymer of a diblock (A-B) structure where A is an ionic water-soluble polymer block (for example, (meth)acrylic acid) and B is a hydrophobic polymer block, where A constitutes at least 60% of the total polymer. The copending application 10/197,555 also claims a cosmetic composition containing a water-soluble or water-dispersible polymer but the polymer is a triblock (A-B-A) where A is

• Application No. 10/070,911  
Reply to Office Action of November 3, 2004

defined as (meth)acrylic acid and B is defined as styrene. However, the claims of these two applications do not describe or suggest selecting polymers with LCST unit having the necessary heat-induced demixing temperature required in the claims of the present application. Therefore, Applicants request withdrawal of the rejections as they pertain to U.S. application serial nos. 10/197,560 and 10/197,555.

Priority

✓ Applicant points out that a certified copy of the French priority application was submitted to the International Bureau in the PCT application from which the present 371 application was filed (see the attached copy of the Request filed by the Applicants when the current U.S. application was filed).

Applicants request allowance of this application. Early notice of such allowance is also requested.

Respectfully submitted,

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Florence L'ALLORET, et al.

SERIAL NO.: NEW U.S. PCT APPLICATION

FILED: HEREWITH

INTERNATIONAL APPLICATION NO.: PCT/FR02/00122

INTERNATIONAL FILING DATE: January 14, 2002

FOR: COMPOSITION WITH AN OPTICAL EFFECT, ESPECIALLY COSMETIC COMPOSITIONS

COPY

**REQUEST FOR PRIORITY UNDER 35 U.S.C. 119**  
**AND THE INTERNATIONAL CONVENTION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In the matter of the above-identified application for patent, notice is hereby given that the applicant claims as priority:

**COUNTRY**

France

**APPLICATION NO**

01 00481

**DAY/MONTH/YEAR**

15 January 2001

Certified copies of the corresponding Convention application(s) were submitted to the International Bureau in PCT Application No. PCT/FR02/00122.

Respectfully submitted,  
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